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APR 23 2004

OFFICE OF PETITIONS

In re Application of :
Oshima : DECISION GRANTING
Appl. No. 09/740,068 : PETITION UNDER
Filed: December 20, 2000 : 37 CFR 1.183
Attorney Docket NO. 2000_1727 :

This is a decision on the April 6, 2004, "Petition Under 37 CFR 1.183 to Accept Substitute Specification in Reissue Application" requesting waiver of the 37 CFR 1.125(d) prohibition against the filing of a substitute specification in a reissue application. The petition is being treated under 37 CFR 1.183 for waiver of 37 CFR 1.173(a)(1) in addition to waiver of 37 CFR 1.125(d).

In order to permit entry of the March 30, 2004, "Amendment under 37 C.F.R. 1.312 after Receipt of Notice of Allowance," petitioner also requests waiver of the requirement that any amendment under 37 CFR 1.312 be filed before or with the payment of the issue fee. That request is also being treated herewith under 37 CFR 1.183.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is granted.

A fee of \$130.00 has been charged to Deposit Account No. 23-0975 for the petition under 37 CFR 1.183, as authorized by the petition.

DECISION

37 CFR 1.125(d) prohibits the filing of a substitute specification in a reissue application, while the present petition requests entry of the substitute specification filed on October 2, 2003. Accordingly, this petition is being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.125(d). 37 CFR 1.173(a)(1) requires the filing of the specification in the form of "a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper." The substitute specification filed on October 2, 2003 is not a copy of the printed patent, in double column format. Accordingly, this petition is also being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.173(a)(1).

The reissue application was originally filed with a

specification in double column format that complied with 37 CFR 1.173(a)(1). On October 2, 2003, a substitute specification was filed together with a supplemental reissue declaration, proposed drawing amendments, and replacement drawings. Accompanying the items filed on October 2, 2003, was a paper styled "Submission of Supplemental Reissue Declaration, Substitute Specification, Proposed Drawing Amendments, and Formal Drawings" stating that all of the items were being filed "[P]ursuant to a telephone conversation with the Examiner."¹ The examiner marked the first page of the substitute specification with the notation "accepted," which he initialed and dated October 20, 2003. The substitute specification was entered in the application and on November 26, 2003, a "Notice of Allowability" was mailed.

Petitioner is requesting waiver of the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) based on the fact that the reissue application has already been allowed using the substitute specification which was apparently filed pursuant to an agreement with the examiner. This basis is considered to be sufficient for granting the petition. The rule will be waived to comply with the requirement of the examiner, since there is no other way to present the required substitute specification, and the requirement for the substitute specification by the examiner is deemed appropriate.

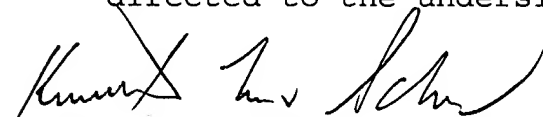
Petitioner also requests waiver of the requirement that any amendment under 37 CFR 1.312 be filed before or with the payment of the issue fee. In this regard, it is noted that the issue fee was paid on February 18, 2004, and that the relevant amendment under 37 CFR 1.312 was filed by facsimile on March 30, 2004. The § 1.312 amendment was filed in response to a March 30, 2004 telephone communication between USPTO Legal Advisor, James Engel and petitioner's counsel. During that telephone communication, Mr. Engel indicated certain corrections required to be made to the first paragraph of the specification referencing related applications. Once again it is deemed appropriate to waive the rule to obtain entry of the required information.

CONCLUSION

1. The request under 37 CFR 1.183 to waive the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) is granted.
2. The request under 37 CFR 1.183 to waive the requirement that any amendment under 37 CFR 1.312 be filed before or with the payment of the issue fee is granted.
3. The substitute specification filed on October 2, 2003 is accepted, and will be entered.
4. The March 30, 2004 amendment under 37 CFR 1.312 is accepted, and will be entered.

¹ No other record of the referenced telephone conversation can be found in the application file.

5. The reissue application file is being forwarded for entry of the substitute specification filed October 2, 2003 and the amendment under 37 CFR 1.312 filed March 30, 2004.
6. Thereafter, the reissue application file will be forwarded to Office of Patent Publication.
7. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-6710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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